

## **REMARKS**

This is a full and timely response to the outstanding non-final Office Action mailed October 6, 2004. Reconsideration and allowance of the application and pending claims are respectfully requested.

### **I. Claim Rejections - 35 U.S.C. § 112, Second Paragraph**

Claims 1-29 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention.

Claims 1, 4, 10-11, 13-14, 17-19, 23, and 26-28 have been rejected for their usage of the term “identifier”. In particular, the Office Action states that it is unclear to which object that term pertains. In view of this rejection, Applicant has amended the limitations that comprise the “identifier” limitation to remove any indefiniteness. For example, claim 1 has been amended to recite “providing said file with an identifier in a header of said file that provides an indication of an algorithm that was used to encrypt said file”.

Claim 3 has been rejected for its recital of “postscript”, “.pcl”, “.pdf”, and “.xml”. In response to the rejection, “.pcl”, “.pdf”, and “.xml” have been replaced with “PCL”, “PDF”, and “XML” respectively. As for the use of the term “printer description language” in conjunction with “postscript”, “.pcl”, “.pdf”, and “.xml”, Applicant notes that the term “printer description language” of claim 1 is used as a generic term to identify printer-readable formats. Claim 3 provides specific examples of such formats. Accordingly, the use of “printer description language” in claim 1 and “postscript”, “.pcl”, “.pdf”, and “.xml” in claim 3 are believed to be consistent.

Claims 5 and 19 have been rejected for reciting a flag that is “recognizable solely by the printer”. Applicant traverses the rejection on the grounds that it is possible to provide a flag that is recognizable by only the printer given that that printer is the only device that is intended to recognize it. In other words, the computer that provides the flag need not be able to recognize the flag because the computer is not intended to ever receive the encrypted file. That the computer cannot “recognize” the flag does not mean that the computer cannot *provide* the flag to the recipient printer. Accordingly, Applicant has not amended the above-described limitation in claim 5.

Claims 7 and 14 have been rejected as being confusing as to which actions are performed by which devices. In response, Applicant has amended claims 7 and 14 to remove any such ambiguity.

Claim 14 has been rejected as referring to claim 13 and reciting “said providing”. Although it is true that the “providing” recitation appears in claim 11 and not 13, Applicant notes that claim 13 indirectly depends from claim 11, and therefore incorporates its limitations. Accordingly, the reference to the “providing” recitation contained in claim 14 is believed to be proper.

Claim 18 has been rejected for the phrase “wherein at least one processor of said first device includes at least one encryption algorithm”. In response, Applicant has amended claim 18 to state that the “first device includes at least one encryption algorithm”.

Claim 19 has been rejected for its recitation of a “source of identifiers”. In response to this rejection, that recitation has been removed from the claim.

Claim 22 has been rejected for use of the phrase “remotely in time”. In response, Applicant has removed that phrase from claim 22.

Claim 28 has been rejected for reciting “said decryption key corresponding to said flag for facilitating recognition thereof”. In response, Applicant has amended claim 28 to recite “said decryption key corresponding to said identifier”.

In view of the above-described amendments and arguments, it is respectfully asserted that claims 1-29 define the invention in the manner required by 35 U.S.C. § 112. Accordingly, Applicant respectfully requests that the rejections to those claims be withdrawn.

## **II. Claim Rejections - 35 U.S.C. § 102(e)**

Claims 1-4, 11-12, 17-18, 21, and 23-25 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Chan, et al. (“Chan,” U.S. Pat. No. 6,378,070). Applicant respectfully traverses this rejection.

It is axiomatic that “[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration.” *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(e). In the present case, not every feature of the claimed invention is represented in the Chan reference.

As is indicated above, each of Applicant’s independent claims has been amended to remove ambiguity regarding the term “identifier”. For example, independent claim 1 recites “providing said file with an identifier in a header of said file that provides an indication of an algorithm that was used to encrypt said file”. Applicant notes that Chan does not teach or suggest providing a file with an “identifier”. Furthermore, Chan does not teach or suggest providing such an identifier

in a “header” of the file. Moreover, Chan does not teach or suggest providing an identifier to the file that “provides an indication of an algorithm that was used to encrypt said file”. For at least those reasons, Chan does not anticipate Applicant’s claim 1. Applicant notes that Chan is similarly deficient in regard to independent claims 11, 17, and 23.

Due to the shortcomings of the Chan reference described in the foregoing, Applicant respectfully asserts that Chan does not anticipate Applicant’s claims. Therefore, Applicant respectfully requests that the rejection of those claims be withdrawn.

### **III. Claim Rejections - 35 U.S.C. § 103(a)**

#### **A. Rejection of Claims 1-3, 11-12, 17-18, and 21-25**

Claims 1-3, 11-12, 17-18, and 21-25 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Matsui, et al. (“Matsui,” U.S. Pat. No. 6,167,514) in view of Hirst, et al. (“Hirst,” U.S. Pat. No. 5,930,553) and the Printerdriver.net article. Applicant respectfully traverses this rejection.

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office (“USPTO”) has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. *See In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure.

In the present case, the applied references do not teach or suggest all of Applicant's claim limitations.

As is noted above, each of Applicant's independent claims has been amended to remove ambiguity regarding the term "identifier". For example, independent claim 1 recites "providing said file with an identifier in a header of said file that provides an indication of an algorithm that was used to encrypt said file". Applicant notes that none of the applied references teach or suggest providing a file with an "identifier", providing such an identifier in a "header" of the file, or providing an identifier that "provides an indication of an algorithm that was used to encrypt said file". For at least those reasons, the combined references do not render Applicant's claim 1 obvious. Furthermore, those references are deficient in regard to independent claims 11, 17, and 23, which comprise similar recitations regarding the identifier.

In view of the above, it is respectfully submitted that claims 1-3, 11-12, 17-18, and 21-25 are patentable over Matsui, Hirst, and the Printerdriver.net article, and that the rejection of these claims should be withdrawn.

**B. Rejection of Claim 4**

Claim 4 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Matsui in view of Hirst, the Printerdrive.net article, and the Math.Berkeley.edu article. Applicant respectfully traverses this rejection.

As is identified above in reference to independent claim 1, Matsui, Hirst, and the Printerdriver.net article do not teach or suggest each of Applicant's claim limitations. In that the Math.Berkeley.edu article does not remedy the deficiencies of Matsui, Hirst, and the Printerdriver.net article, Applicant respectfully submits that claim 4, which depends from claim 1, is allowable for at least the same reasons that claim 1 is allowable.

**C. Rejection of Claims 5-10, 13-16, 19-20, and 26-29**

Claims 5-10, 13-16, 19-20, and 26-29 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Matsui in view of Hirst and the Printerdriver.net article, and further in view of Chen (U.S. Pat. No. 6,058,187) and Leppek (U.S. Pat. No. 6,233,338). Applicant respectfully traverses this rejection.

As is identified above in reference to independent claims 1, 11, 17, and 23, Matsui, Hirst, and the Printerdriver.net article do not teach or suggest each of Applicant's claim limitations. In that the Chen and Leppek references do not remedy the deficiencies of Matsui, Hirst, and the Printerdriver.net article, Applicant respectfully submits that claims 5-10, 13-16, 19-20, and 26-29 are allowable for at least the same reasons that claims 1, 11, 17, and 23 are allowable.

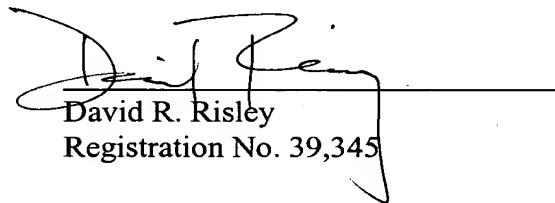
#### **IV. Canceled Claims**

As identified above, claims 6, 9, and 15 have been canceled from the application through this Response without prejudice, waiver, or disclaimer. Applicant reserves the right to present these canceled claims, or variants thereof, in continuing applications to be filed subsequently.

## CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Assistant Commissioner for Patents, Alexandria, Virginia 22313-1450, on

1-16-05

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Signature